



[3510-16-P]

DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

[Docket No. PTO-P-2015-0049]

Change in Practice Regarding Correction of Foreign Priority Claims

AGENCY: United States Patent and Trademark Office, Commerce

ACTION: Notice.

SUMMARY: The American Inventors Protection Act of 1999 (AIPA) provided for publication of patent applications at eighteen months from the earliest filing date for which a benefit is claimed. Thus, the patent laws and regulations require that foreign priority or domestic benefit claims, specifying the application number, country (or intellectual property authority), and filing date of any foreign application for which priority is claimed and the application number of any domestic application for which benefit is claimed, be submitted in a timely manner to allow for publication at eighteen months from the earliest filing date for which a benefit is claimed. It has been United States Patent and Trademark Office (USPTO) practice to require that any correction of

the application number in a domestic benefit claim after the time period for filing a priority or benefit claim be via a petition to accept an unintentionally delayed benefit claim, but to permit correction of the application number in a foreign priority claim after the time period for filing a priority or benefit claim without such a petition. This dissimilar treatment of the correction of foreign priority claims and domestic benefit claims results in the publication of a corrected patent application publication reflecting the accurate domestic benefit claim information whenever an applicant corrects the application number in a domestic benefit claim in a pending application, but not whenever an applicant corrects the application number of the foreign application in a foreign priority claim. The rationale for the practice of permitting correction of the application number in a foreign priority claim without a petition was because the filing date of a prior foreign patent application did not affect the effective prior art date of a U.S. patent application publication and because the USPTO schedules publication of an application with the filing date provided by applicant in a foreign priority claim. The Leahy-Smith America Invents Act (AIA), however, now provides that the filing date of an earlier foreign patent application may now be the effective prior art date for subject matter disclosed in a U.S. patent or a U.S. patent application publication. Therefore, U.S. patent application publications should reflect accurate foreign priority information to minimize the burden on examiners and members of the public in assessing the effective prior art date for subject matter disclosed in such U.S. patent application publications. The USPTO will thus now require that any correction of the identification of the foreign application (by application number, country (or intellectual property authority), and filing date) in a foreign priority claim after the time period for filing a priority or benefit claim

be via a petition to accept an unintentionally delayed priority claim, and once the petition is granted in a pending application, will now publish a corrected patent application publication reflecting the accurate foreign priority claim information. Requiring a petition and publishing a corrected patent application publication whenever an applicant corrects the application number in a foreign priority claim or a domestic benefit claim will provide for common treatment of the correction of the identification of a foreign or domestic application in a priority or benefit claim. The publication of a corrected patent application publication by the USPTO will result in corrected patent application publications with accurate foreign priority information which will benefit examiners, applicants and members of the public in assessing the effective prior art date for subject matter disclosed in a U.S. patent application publication.

DATES: Effective Date: The change in this notice takes effect on **[INSERT DATE 30 DAYS AFTER PUBLICATION IN THE FEDERAL REGISTER]**. Any corrections to the foreign application number in a foreign priority claim that were previously accepted are not affected by this change in practice.

FOR FURTHER INFORMATION CONTACT: Eugenia A. Jones, Senior Legal Advisor, by telephone at (571) 272-7727, or Erin M. Harriman, Legal Advisor, by telephone (571) 272-7747, Office of Patent Legal Administration, Office of the Deputy Commissioner for Patent Examination Policy, or by mail addressed to: Mail Stop Comments--Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, marked to the attention of Eugenia A. Jones.

SUPPLEMENTARY INFORMATION:

Background: In view of the AIPA, foreign priority or domestic benefit claims must be submitted in a timely manner to allow for publication of patent applications at eighteen months from the earliest filing date for which a benefit is claimed. See 35 U.S.C. 122(b). The requirements for making a domestic benefit claim are set forth in 37 CFR 1.78 and the requirements for making a foreign priority claim are set forth in 37 CFR 1.55. As provided in 37 CFR 1.55 and 1.78, the claim for priority or benefit must be filed within the later of four months from the actual filing date of the application or sixteen months from the filing date of the prior application (hereinafter referred to as the 4/16 month time period) in a patent application filed under 35 U.S.C. 111(a). Note that the 4/16 month time period does not apply to an application for a design patent or an application filed before November 29, 2000. A claim for foreign priority must identify the foreign application by specifying the application number, country (or intellectual property authority), and the filing date (day, month, and year) of the foreign application. See 37 CFR 1.55(d).

It has been USPTO practice to require that any correction of the application number in a domestic benefit claim after the 4/16 month time period be via a petition to accept an unintentionally delayed benefit claim, but to permit correction of the application number in a foreign priority claim after the 4/16 month time period without such a petition (discussed in the Eighteen-Month Publication Questions and Answers on the USPTO Web site). This dissimilar treatment of the correction of foreign priority claims and

domestic benefit claims results in the publication of a corrected patent application publication reflecting the accurate domestic benefit claim information whenever an applicant corrects the application number in a domestic benefit claim in a pending application, but not whenever an applicant corrects the application number of the foreign application in a foreign priority claim. The rationale for this practice was because the USPTO was able to schedule the application for publication with the filing date of the foreign application provided by applicant and the prior art date under pre-AIA 35 U.S.C. 102(e) of the publication was not affected. See the Patent FAQs web page available at <http://www.uspto.gov/help/patent-help>.

Under the first inventor to file provisions of the AIA, a U.S. patent or patent application publication may be effective as prior art as of the filing date of an earlier foreign application. See AIA 35 U.S.C. 102(d) and the Manual of Patent Examining Procedure (MPEP) (9th Ed. 2014), Section 2154.01(b). Therefore, the rationale for not requiring a petition to correct an error in the application number of a foreign priority claim is no longer appropriate. In view of the first inventor to file provisions of the AIA, U.S. patent application publications should reflect accurate foreign priority information to minimize the burden on examiners and members of the public in assessing the effective prior art date for subject matter disclosed in such U.S. patent application publications.

Change in Practice: The USPTO will now require compliance with all the requirements of 37 CFR 1.55 and thus require a petition to accept an unintentionally delayed claim for foreign priority under 37 CFR 1.55(e) in order to correct any error in a foreign priority

claim if the correction is being made after the 4/16 month time period. This is consistent with the practice for correcting any error in a domestic benefit claim under 37 CFR 1.78 if the correction is being made after the 4/16 month time period and will result in a corrected patent application publication with the accurate foreign priority information being published by the USPTO for a pending application.

Requiring compliance with all the requirements of 37 CFR 1.55 will create consistency between the practices under 37 CFR 1.55 and 1.78 and will result in corrected patent application publications with accurate foreign priority information being published by the USPTO. A U.S. patent application publication which claims priority to a foreign application that identifies the correct foreign application number, country (or intellectual property authority), and date of filing will help ensure that proper examination of patent applications being examined under the first inventor to file provisions of the AIA will occur. Identification of the correct foreign priority information on U.S. patent application publications will also minimize the burden on examiners and members of the public in obtaining a copy of the correct foreign priority document in the event that a copy is not available in the application file of the reference. This change in practice will benefit examiners, applicants, and members of the public by reducing any uncertainty caused by the dissimilar treatment of the correction of foreign priority claims and domestic benefit claims and by ensuring that a corrected U.S. patent application publication reflecting accurate foreign priority information will be published by the USPTO enabling accurate assessment of the effective prior art date for subject matter disclosed in U.S. patent application publications.

The Patent FAQs will be modified to reflect that a petition under 37 CFR 1.55(e), including the petition fee, will be required to correct any error in a foreign priority claim after the 4/16 month period of 37 CFR 1.55(d).

Dated: September 26, 2015. _____

Michelle K. Lee,
Under Secretary of Commerce for Intellectual Property and
Director of the United States Patent and Trademark Office.
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